

### Remarks

Applicant has amended the claims to more distinctly point out and claim the differences between the invention and the prior art cited by the Examiner, and to address the rejection raised in the Office Action based upon 35 U.S.C. 112. Support for this amendment is found throughout the specification at, for example, in paragraph 39. *See In re Gardner*, 177 USPQ 396, 397 (CCPA 1973) and MPEP §§ 608.01(o) and (l) (8<sup>th</sup> ed. Rev. 6, Sept. 2007, pp. 600-92 and 600-84).

No impermissible new matter is added by this amendment.

In the Office Action dated August 13, 2008, the Examiner rejected pending claim 81 under 35 U.S.C. 112 as indefinite on the grounds that there was an inclusion of the closure in both independent claim 80 and dependent claim 81. Applicant has herein amended claims 80 and 81 to resolve this rejection.

In the August 13, 2008 Office Action, the Examiner also rejected pending claims 80, 81, 83, 84, 86 and 87 as obvious over Morash '206 in view of Kornely et al. '768 and Wells '743. However, these references cannot be combined to disclose all of the limitations of the rejected claims. The present invention is based on the principle of keeping the inside of a baby or toddler feeding bottle sterile prior to filling with a beverage, such as milk. This is achieved by providing sterilized components of the bottle in a stackable form. In particular, the container part of the bottle has a cover sealed to the rim thereof and which extends into the container, thus allowing the containers to be stacked. When a container is removed from a stack to be used, the cover is peeled off for the container to be filled. This means that the sterile integrity of the next container in the stack is not impaired, regardless whether a container has been removed from the top or the bottom of the stack.

Morash, on the other hand, relies on one container body to protect the next container body. Accordingly, Morash does not disclose the use of a cover sealed over a container body rim to maintain it in a sterile condition. Because of this absence, Morash has certain deficiencies that are addressed by the present invention. While Morash requires that a fresh container may only be taken from the bottom of a stack in order to preserve the sterility of the adjacent container, in practice there is no guarantee that this procedure will be followed, as it is just as easy for the user to remove the top, rather than the bottom container from the stack. Removal of the top container will expose the interior of the next container down in the stack, so that sterility is lost.

Secondly, Morash discloses only a friction fit between the respective inner and outer surfaces, respectively, of successive containers in the stack. This does not provide sterility of the interior of the successive containers down in the stack, as the containers are made from plastics material, which is flexible, and are liable to distortion from temperature changes or external forces. For example, if the container stack is carried in a soft bag amongst other objects, Force from other objects against the container stack can cause distortion that can create a gap between adjacent containers. Any gap, no matter how small or temporary, is sufficient to destroy sterility.

Thus, Morash does not disclose a seal that is capable of maintaining sterility. It does not disclose the present claim limitations of a removable cover protecting the interior of the container from contamination. By contrast, the present invention provides a sealed cover over the mouth of the container, which extends into the container both maintain sterility of the interior of the container until required for use and allows stacking without the risk of distortion affecting the seal of the cover over the mouth of a container.

Nor does the combination of Kornely with Morash provide the claim limitations of a removable cover protecting the interior of the container from contamination. Morash shows stacked components for a feeding bottle and Kornely merely shows a plastic liner used solely for abrasion and impact protection purposes. The protective liner of Kornely is not used to keep sterilised feeding bottles free from contamination, but rather as a protective liner for items, such as cooking pans or trays, which are transported in stacked arrangements. The protective liners of Kornely are only intended to provide protection against damage to non-stick surface during manufacture, packaging, shipping and display by covering the non-stick surfaces.

Kornely is only concerned with preventing particles of dust or grit from causing surface damage. Kornery is not concerned with keeping the interior of a container free from bacterial contamination and the protective covers are not sealed to the rims of pans or trays to prevent contamination of the interiors of the pans or trays. To the contrary, as disclosed in Kornery, the covers are merely held in place by the friction fit arising from the elastic properties of the liner material: "the resilient indentations 19 rest underneath the rim 16 to hold the channel 12 in place." (Col. 3, lns. 27-28). This disclosed friction fit would not secure the inside of the container from contamination.

Conversely, the protective liners of the present invention are not intended to prevent surface damage to the interior of a container. Surface damage is not an issue of concern for the present invention. The main concern is to ensure that the interior of the container is free from contamination before use. The intention is for the container body to be sterilised and kept free from bacterial contamination until it is needed for filling with milk or other liquid drink suitable for a baby or toddler. Accordingly, it is quite clear that providing a cover of the Kornely type on components of a Morash feeding bottle would not result in the present invention, because

Kornely and the present invention are intended for solving quite different problems, namely protection against surface damage and protection against contamination.

The Examiner's cited reference to Wells 5,702,743, which discloses a reclosable bacon package, is neither relevant nor applicable to Morash or Kornely, nor to the present invention. Wells discloses only a rigid tray and a rigid cover. There is no reference or teaching in Wells to suggest application of its bacon package to beverage containers or stackable containers. Thus, Morash '206, Kornely et al. '768, and Wells '743 are insufficient to serve as references for obviousness rejections for claims 80, 81, 83, 84, 86 and 87, as they do not disclose a removable cover protecting the interior of stackable beverage containers from contamination.

Accordingly, it is quite clear that providing a cover of the type disclosed in Kornely on components of a feeding bottle as described in Morash would not result in the present invention, because Kornely and the present invention are intended for solving quite different problems: namely protection against surface damage, and protection against contamination. Thus, the obviousness rejection on this basis should be withdrawn.

It is well settled that the Examiner bears the burden to set forth a *prima facie* case of unpatentability. *In re Glaug*, 62 USPQ2d 1151, 1152 (Fed. Cir. 2002); *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); and *In re Piasecki*, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet its burden, then the applicant is entitled to a patent. *In re Glaug*, 62 USPQ2d at 1152.

When patentability turns on the question of obviousness, as here, the search for and analysis of the prior art by the PTO should include evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to modify the document(s) relied on by the Examiner as evidence of obviousness. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1731-32

(2007) (the obviousness “*analysis should be made explicit*” and the teaching-suggestion-motivation test is “*a helpful insight*” for determining obviousness) (emphasis added); *McGinley v. Franklin Sports*, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). Moreover, the factual inquiry as to whether to modify a reference must be thorough and searching. And, as is well settled, the teaching, motivation, or suggestion to modify the reference(s) should “*be based on objective evidence of record*.” *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (emphasis added); *see also In re Kotzab*, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000).

Here, the rejection is devoid of *any* evidence - or even argument - in support of the proposed modification. All that is there are conclusory remarks that “To have further provided the containers with a plastic cover extending down into the container to seal it and protect it and to provide easy separation and stacking purposes would have been obvious in view of such teaching by Kornely et al.” and “To have sealed the covers at the rim to provide a hermetic seal would have been obvious in view of such teaching by Wells.” (Paper No. 20080811 at para. 3). What the rejection should have done, but did not, was to explain on the record *why* one skilled in this art would modify the disclosure of Morash in view of Kornely et al. ‘768, and Wells ‘743 to arrive at the claimed invention. As is well settled, an Examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done. *Takeda Chem. Indus., Ltd v. Alphapharm Pty., Ltd.*, 2007 U.S. App. LEXIS 15349, \*12 (Fed. Cir. June 28, 2007) (indicating that “it remains necessary to identify *some reason* that would have led a chemist to modify a known compound in a particular manner to establish prima facie obviousness of a new claimed compound”) (emphasis added); *Ex parte Levengood*, 28 USPQ2d 1300, 1301-02 (BPAI 1993). But this is precisely what the

Examiner has done here. Thus, the rejection is legally deficient and should be withdrawn for this reason alone.

Notwithstanding the legally insufficient nature of the rejection, we note that the rejection is also factually insufficient to support a rejection under § 103(a). In doing so we observe that obviousness cannot be based upon speculation, nor can obviousness be based upon possibilities or probabilities. Obviousness *must* be based upon facts, “cold hard facts.” *In re Freed*, 165 USPQ 570, 571-72 (CCPA 1970). When a conclusion of obviousness is not based upon facts, it cannot stand. *Ex parte Saceman*, 27 USPQ2d 1472, 1474 (BPAI 1993). Further, “to establish *prima facie* obviousness of a claimed invention, *all claim limitations must be taught or suggested by the prior art.*” MPEP § 2143.03 (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)) (emphasis added).

As noted above, independent claim 80 requires that the **“container body before use has a removable cover protecting the interior thereof from contamination.”** As noted above, Kornely characterize their disclosure as providing “a protective liner for vessels such as cooking pans, which have interior surfaces either natural or covered with thin, nonstick coatings.” Abstract. Also as noted above, Wells characterizes its disclosure as providing “A shaped generally rigid, synthetic plastic package having multiple stacks of sliced bacon...” (Abstract).

In view of the disclosures of Jacobsen, one skilled in the art would not consider Kornely or Wells as teaching or suggesting that the **“container body before use has a removable cover protecting the interior thereof from contamination”** as recited in the rejected claims. There is no disclosure in either reference that would indicate to one skilled in the art that the **“container body before use has a removable cover protecting the interior thereof from contamination.”**

For each of the foregoing reasons, it is submitted that the rejection based upon Morash '206, Kornely et al. '768, and Wells '743 is deficient and should be withdrawn.

Reconsideration and withdrawal of the rejection is requested.

The Examiner's rejections of independent claim 114 and the remaining pending dependent claims in paragraphs 4-8 of the Office Action are predicated on Morash '206, Kornely et al. '768, and Wells '743, further in view of one of Williams WO '074, Verbovsky '053, Haberman '245, Kornely et al. '768, Lynch '811, or Nemeth '715. However, the Examiner's rejections are devoid of any discussion of Morash '206, Kornely et al. '768, or Wells '743. For each of the rejections in paragraphs 4-8 of the Office Action the Examiner simply asserts that the additional claim limitation is disclosed in the cited additional reference, without any mention of Morash '206, Kornely et al. '768, or Wells '743, or their teachings, or how the feature disclosed in the additional reference is taught or suggested for incorporation.

Accordingly, the record is devoid of any evidence that the Examiner individually considered any of the dependent claims in connection with the rejection over Morash '206, Kornely et al. '768, and Wells '743. It is axiomatic, however, that a dependent claim is not *per se* unpatentable by a document that allegedly makes unpatentable the base claim. Accordingly, "[e]xaminers are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. *It is this combination that must be compared with the prior art, exactly as if it were presented as one independent claim.*" MPEP § 608.01(n) (8<sup>th</sup> ed., Rev. 5, Aug. 2006, pp. 600-91). This the Examiner has not done.

Accordingly, these rejections are both factually and legally deficient as to claim 114 and the other dependent claims. For this additional reason, the rejections should be withdrawn as to all these claims.

In Paragraph 4 of the Office Action dated August 13, 2008, the Examiner also rejected pending claims 82 and 114-116 as obvious over Morash '206 in view of Kornely et al. '768 and Wells '743, and further in view of Lynch '811. For the same reasons as expressed above for claims 80, 81, 83, 84, 86 and 87, Morash '206, Kornely et al. '768 and Wells '743 are insufficient to serve as references for obviousness rejections for claims 82 and 114-116, as they do not disclose a removable cover protecting the interior of the container from contamination.

In Paragraph 5 of the August 13, 2008 Office Action, the Examiner also rejected pending claims 85 and 117 as obvious over Morash '206 in view of Kornely et al. '768 and Wells '743 and further in view of Lynch '811 and Nemeth '715. For the same reasons as expressed above for claims 80, 81, 83, 84, 86 and 87, Morash '206, Kornely et al. '768 and Wells '743 are insufficient to serve as references for obviousness rejections for claims 85 and 117, as they do not disclose a removable cover protecting the interior of the container from contamination. Further, because Nemeth relates to a container for computer media, any teachings therein regarding use of a Polystyrene cover would not apply to the present invention for a vessel for sterile liquids.

In Paragraph 6 of the Office Action, the Examiner also rejected pending claims 88-94, 103-110 and 118 as obvious over Morash '206 in view of Kornely et al. '768 and Wells '743 and further in view of Williams et al. WO '074. For the same reasons as expressed above for claims 80, 81, 83, 84, 86 and 87, Morash '206, Kornely et al. '768 and Wells '743 are insufficient to serve as references for obviousness rejections for claims 88-94, 103-110 and 118, as they do not disclose a removable cover protecting the interior of the container from contamination.

In Paragraph 7 of the August 13, 2008 Office Action, the Examiner also rejected pending claims 94, 96, 97, 101 and 102 as obvious over Morash '206 in view of Kornely et al. '768 and



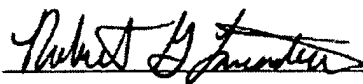
Wells '743 and further in view of Verbovsky '053. For the same reasons as expressed above for claims 80, 81, 83, 84, 86 and 87, Morash '206, Kornely et al. '768 and Wells '743 are insufficient to support an obviousness rejection for claims 94, 96, 97, 101 and 102, as they do not disclose a removable cover protecting the interior of the container from contamination.

In Paragraph 8 of the Office Action, the Examiner also rejected pending claims 95-102 as obvious over Morash '206 in view of Kornely et al. '768 and Wells '743 and further in view of Haberman '245. For the same reasons as expressed above for claims 80, 81, 83, 84, 86 and 87, Morash '206, Kornely et al. '768 and Wells '743 are insufficient to support an obviousness rejection for claims 95-102, as they do not disclose a removable cover protecting the interior of the container from contamination.

In sum, neither Morash nor the other cited references are concerned with maintaining sterility of stackable feeding bottle containers. Accordingly, the cited references are insufficient grounds for rejection of the pending claims.

For all these reasons, it is respectfully submitted that the foregoing amendments and remarks overcome the basis of the Examiner's rejection of the claims. Prompt and favorable reconsideration is respectfully requested. The Examiner is encouraged to contact the undersigned via telephone to resolve any outstanding issues.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Robert G. Lancaster", is written over a horizontal line.

Robert G. Lancaster  
Registration No. 43,736  
BRYAN CAVE LLP  
One Metropolitan Square  
211 North Broadway, Suite 3600  
St. Louis, Missouri 63102-2750  
Tele. (314) 259-2207  
Facs. (314) 259-2020